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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,656	06/29/2001	Alan C. Berkema	10016784-1	9732

7590 10/27/2006

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EXAMINER

POLTORAK, PIOTR

ART UNIT

PAPER NUMBER

2134

DATE MAILED: 10/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/897,656	BERKEMA ET AL.	
	Examiner	Art Unit	
	Peter Poltorak	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 October 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 4,5,9-12,15,18-20,22,32-34 and 37-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 4,5,9-12,15,18-20,22,32-34 and 37-45 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Amendment, and remarks therein, received on 10/06/2006 have been entered and carefully considered.
2. The Amendment introduces amended claims 4-5, 9-12, 15, 18-20, 22 and 32-34 and added new claims 40-45. The amendments have required a new search and consideration of the pending claims. The new search has resulted in newly discovered prior art. New grounds of rejection based on the newly discovered prior art follow below.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

Response to Amendment

4. Applicant's arguments have been carefully considered.
5. Applicant's arguments seem to be directed towards the newly introduced limitations.

As a result, they are addressed in this Office Action, below.

6. Claims 4-5, 9-12, 15, 18-20, 22, 32-34 and 37-45 have been examined.

Claim Rejections - 35 USC § 103

7. Claims 4,19, 32-34, 40, 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry (U.S. Patent No. 6385728) in view of Bluetooth as evidenced by Nordman (U.S. Pub. No. 20020174364).

8. As per claims 4, 19, 32-34, 44 DeBry discloses communicating a reference to a print device (print server 30), the reference (a will-call certificate) identifying a location at which a print content (requested document to be printed) is located on a network and the location of a print service (a document source 10), wherein the reference causes the print device to retrieve the print content from the network and to print the print content (Fig. 2 and 3, col. 5 lines 5-7, col. 6 lines 55-64, col. 7 lines 20-51 and col. 8 lines 6-36). Furthermore, DeBry discloses communicating a security access code (a digital signature) to the print device wherein the access code enables access to the print content (col. 7 line 15 – col. 8 line 36). Additionally, DeBry discloses a security access code (encrypted message) in response to a security challenge received from the print device used to restrict access to the print device (Fig. 4 and col. 9 lines 5-27).
9. As per storing and retrieving the reference from a memory of the computer, computer programs (computer readable code) facilitate operation of a computer, and computers use memory to process (store and retrieve) information when accessing, receiving, sending and operating on data. As a result, DeBry's disclosure of a computer communicating a reference to a print device wherein the reference identifying a location at which a print content is located on a network and the location of a print service reads on the claim limitations.
10. As per claims 40, DeBry discloses the need for ability to control the number of copies being distributed, e.g., to protect copyright in the document and/or payment of a fee on a per-copy basis (col. 4 line 67 – col. 5 line 2) that results in a user

paying a fee for the right of printing the print content (col. 7 lines 7-13). Furthermore, DeBry discloses the reference data comprises a serial number for tracking purposes (Fig. 2 and col. 7 lines 30-35). As a result it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to utilize a serial number as billing information given the benefit of uniquely identifying a transaction and enabling appropriate charge for the printed content.

11. DeBry does not teach that the communication is a wireless communication and does not receiving a responsive signal from a print device in response to a wirelessly communicated discovery signal for locating one or more print devices.

Bluetooth disclosed by Nordman is a wireless communication, wherein a response signal from a device (such as a print device) to a discovery signal, wherein the response signal comprises a physical location of the responding device (Bluetooth Device Address, Nordman [3]). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to communicate a wireless discovery system to receive a responsive signal from a print device as taught by Nordman. One of ordinary skill in the art would have been motivated to perform such a modification in order to find devices providing available services in vicinity of a requester.

12. Claims 41 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry (U.S. Patent No. 6385728) in view of Bluetooth as evidenced by Nordman (U.S. Pub. No. 20020174364) in view of Ferlitsch (U.S. Pub. No. 20020114004).

DeBry in view of Bluetooth disclose wirelessly communicating the reference to a print device as discussed above.

13. Debry in view of Bluetooth do not disclose that after communicating the reference to the print device, a request for status information to the print device is sent, and that the status information includes at least one of status of retrieval of the print content and status of printing the print content.

Ferlitsch discloses sending a request for status information to the print device, the status information including at least one of status of retrieval of the print content and status of printing the print content (Ferlitsch [79-80]). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to send a request for status information to the print device, the status information including at least one of status of retrieval of the print content and status of printing the print content as taught by Ferlitsch. One of ordinary skill in the art would have been motivated to perform such a modification in order to determine the progress of the print job.

14. Claims 9-12, 15, 20 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry (U.S. Patent No. 6385728) in view of Larsson (International Publication No. WO 0142894).

DeBry discloses communicating a reference to a print device (print server 30), the reference (a will-call certificate) identifying a location at which a print content (requested document to be printed) is located on a network and the location of a print service (a document source 10), wherein the reference causes the print device

to retrieve the print content from the network and to print the print content (Fig. 2 and 3, col. 5 lines 5-7, col. 6 lines 55-64, col. 7 lines 20-51 and col. 8 lines 6-36).

DeBry teaches discloses communicating a security access code (a digital signature) to the print device wherein the access code enables access to the print content (col. 7 line 15 – col. 8 line 36).

DeBry's invention aims to ensure that only authorized access to the print content results in the content being sent to the printer for the printing (DeBry, col. 5 lines 11-19). Thus, the access code inherently enables the specific usage of the print device: printing of the requested document. Additionally, DeBry discloses a security access code (encrypted message) in response to a security challenge received from the print device used to restrict access to the print device (Fig. 4 and col. 9 lines 5-27).

15. As per, storing and retrieving the reference from a memory of the computer, the examiner points out that computers use memory to process (store and retrieve) information when accessing, receiving, sending and operating on data. As a result, DeBry's disclosure of a computer communicating a reference to a print device wherein the reference identifying a location at which a print content is located on a network and the location of a print service reads on the claim limitations.

16. DeBry does not specifically disclose a portable wireless device, the print device responding to the print device status information request and the print device sending a response signal identifying one or more of the print capabilities of the print device to print the print content.

Larsson teaches a similar system to that of DeBry, wherein a portable wireless device sends a document address to the printer and then the printer retrieves the document form a document server (Fig. 1, pg. 12 lines 25-29, pg. 13 lines 15-37 and pg. 14 lines 5-11). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to extend DeBry invention by incorporating a portable wireless device as taught by Larsson given the benefit of allowing mobile printing (Larsson, Abstract).

Furthermore, in Larsson's invention the print device responds to the print device status information request (Larsson, pg. 20 lines 26-36) and sends a response signal identifying one or more of the print capabilities of the print device to print content (Larsson, pg. 14 lines 1-3, pg. 16 lines 25-27 and 21 lines 1-6).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include indication of one or more of the print capabilities of the print device to print content in a response signal. One of ordinary skill in the art would have been motivated to perform such a modification so that the print device could receive jobs that is capable to print.

Also, both of the disclosed systems are printing systems with clients, print content and printers and both are concerned with printing documents that are at a remote location (Larsson, pg. 2 lines 16-18 and pg. 4 lines 20-35). In both systems the request to retrieve content is directed to the printer that retrieves the content from an indicated remote location. Also, the device 100 of Larsson can be a cell phone, PDA type device, or even a small computing device (Larsson, pg. 7 lines 25-27), any of

which could perform the generic functions of generic client disclosed by DeBry.

Thus, the advantages of the systems of Larsson and DeBry could have been easily combinable with more than reasonable expectations of success.

17. DeBry discloses the need for ability to control the number of copies being distributed, e.g., to protect copyright in the document and/or payment of a fee on a per-copy basis (col. 4 line 67 – col. 5 line 2) that results in a user paying a fee for the right of printing the print content (col. 7 lines 7-13). Furthermore, DeBry discloses the reference data comprises a serial number for tracking purposes (Fig. 2 and col. 7 lines 30-35). As a result it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to utilize a serial number as billing information given the benefit of uniquely identifying a transaction and enabling appropriate charge for the printed content.

18. Claims 15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry (U.S. Patent No. 6385728) in view of Larsson (International Publication No. WO 0142894) and further in view of Atkinson (U.S. Pub. No. 20020012329) DeBry in view of Larsson teach wireless communication including the response identifying a capability of the print device to print the print content, as discussed above.

19. Furthermore, even if DeBry in view of Larsson did not teach the response identifying a capability of the print device to print the print content, Atkinson teach a response identifying a capability of the print device to print the print content (e.g. Fig. 10).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include a capability of the print device to print the print content in a response. One of ordinary skill in the art would have been motivated to perform such a modification in order to ensure that requests sent to the printer device are requests that the print device could handle.

20. Claims 4, 19, 32-34, 40-41 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry (U.S. Patent No. 6385728) in view of Larsson (International Publication No. WO 0142894) and further in view of Bluetooth as evidenced by Nordman (U.S. Pub. No. 20020174364).

Wireless communication including the security access code, billing information and a response signal addressed by DeBry in view of Larsson's teaching have been discussed above.

21. Debry in view of Larsson do not disclose receiving a responsive signal from a print device in response to a wirelessly communicated discovery signal for locating one or more print devices, the responsive signal identifying a physical location of the print device.

Bluetooth disclosed by Nordman includes a response to a discovery signal, the response signal from a responding device (such as a print device) comprising a physical location of the responding device (Bluetooth Device Address, Nordman [3]).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to communicate a wireless discovery system to receive a responsive signal from a print device as taught by Nordman. One of ordinary skill in the art would have

been motivated to perform such a modification in order to find devices providing available services in vicinity of a requester.

22. Claims 22 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry (U.S. Patent No. 6385728) in view of Larsson (International Publication No. WO 0142894, and further in view of Ferlitsch (U.S. Pub. No. 20020114004).

DeBry in view of Larsson disclose wirelessly communicating the reference to a print device as discussed above.

23. Debry in view of Larsson do not disclose that after communicating the reference to the print device, a request for status information to the print device is sent, and that the status information includes at least one of status of retrieval of the print content and status of printing the print content.

Ferlitsch discloses sending a request for status information to the print device, the status information including at least one of status of retrieval of the print content and status of printing the print content (Ferlitsch [79-80]). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to send a request for status information to the print device, the status information including at least one of status of retrieval of the print content and status of printing the print content as taught by Ferlitsch. One of ordinary skill in the art would have been motivated to perform such a modification in order to determine the progress of the print job.

24. Claims 41 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry (U.S. Patent No. 6385728) in view of Larsson (International Publication No.

WO 0142894) and Bluetooth as evidenced by Nordman (U.S. Pub. No. 20020174364), and further in view of Ferlitsch (U.S. Pub. No. 20020114004).

25. DeBry in view of Larsson and Bluetooth disclose wirelessly communicating the reference to a print device as discussed above.
26. Debry in view of Larsson and Bluetooth do not disclose that after communicating the reference to the print device, a request for status information to the print device is sent, and that the status information includes at least one of status of retrieval of the print content and status of printing the print content.
- Ferlitsch discloses sending a request for status information to the print device, the status information including at least one of status of retrieval of the print content and status of printing the print content (Ferlitsch [79-80]). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to send a request for status information to the print device, the status information including at least one of status of retrieval of the print content and status of printing the print content as taught by Ferlitsch. One of ordinary skill in the art would have been motivated to perform such a modification in order to determine the progress of the print job.
27. Claims 5, 18 and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larsson (International Publication No. WO 0142894) in view of Woo (U.S. Patent No. 6336074).

Larsson discloses a print device (380) comprising a print service (300b), the print device distinct from a content provider (200), and a wireless device (100) wirelessly communicating a reference identifying a location (document address) at which a

print content of the content provider is located on a network (pg. 24 lines 19-30 and pg. 25 lines 17-20), wherein the reference causes the print device to retrieve the print content of the content provider from the network and to print the print content (pg. 25 lines 17-20).

Although, Larsson teaches implicitly communicating a reference (data sent from a portable device to the printer and comprising the reference identifying a location of a print content) to a print device comprising a print service, Larsson does not disclose adding a location of a print service. However, the location of a print service is the same as the location of the print device, and as a result the location of the print service would have to be added to the information sent to the print device in order for the delivery to reach the print device.

28. Larsson does not disclose that the print service is adapted to format the print content for printing.

Woo discloses a print service (print driver) adapted to format the print content (Woo, col. 3 lines 13-25). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to extend print service taught by Larsson to include formatting print content for printing as taught by Woo. One of ordinary skill in the art would have been motivated to perform such a modification in order to allow print device to print documents retrieved in variety of formats.

29. As per claim 37 the wireless device disclosed by Larsson comprises communicates with the content provider using a first communication interface (Larson, Fig. 6 object

118) and transmits the print content to the print device for printing with the print service using a second communication interface (Larson, Fig. 6 object 116).

30. As per claim 39 In pg. 14 lines 5-24 and pg. 21 lines 12-27 Larsson clearly discloses that the second communication interface and the processor is further adapted to cause the second communication interface to transmit the print content to the print device for printing.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

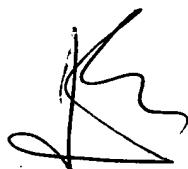
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Poltorak whose telephone number is (571) 272-

3840. The examiner can normally be reached Monday through Thursday from 9:00 a.m. to 4:00 p.m. and alternate Fridays from 9:00 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis Jacques can be reached on (571) 272-6962. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



10/18/01



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